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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,036	11/27/2001	Daniel Y. Abramovitch	10970174-4	3511

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EXAMINER

TRAN, THANG V

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/997,036

Applicant(s)

ABRAMOVITCH ET AL.

Examiner

Thang V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-37 is/are allowed.
- 6) ☒ Claim(s) 38-109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Oath and Declaration***

1. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

2. The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The statement “Applicants and Applicants’ representatives fail to appreciate the full scope of the invention. Specially, other species of claims, which would have been allowable over the prior art, were not submitted to the Office during the examination of the application that issues as US 6,046,968” is not specify enough to be corrected. Accordingly, it is not considered as a specific error to support the reissue application.

3. Claims 1-109 rejected as being based upon a defective reissue oath/decaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/decaration is set forth in the discussion above in this Office action.

***Broaden Claims***

4. Claims 38-109 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process

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which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

The limitations now recited claims 38-109 do not include many particular limitations recited in claims 1-37 of the original patent as compared to each other. Accordingly, claims 38-109 are broader in scope than the original claims in the patent.

5. Claims 38-63, 95, 96, 97 and 100-109 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

The limitation of "and re-writing" was deleted from claims 38, 44, 48, 55, 57, 58, 60, and 95-97 by an amendment filed 12/02/02. This would broaden the scope of claims 38, 44, 48, 55, 57, 58, 60, and 95-97 as compared to that of the original claims in the patent. Claims 39-43, 45-47, 49-54, 56, 59-63 and 100-109 fall with their respective parent claim.

### ***Recapture***

6. Claims 38, 42, 43-46, 48, 53, 54, 64, 68, 70, 72-78, 81, 86, 91 and 92 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221

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USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The Claims 38 , 45 and 46 include the same limitations in claims 1-3, 8 and 9 surrendered in the application for patent.

The Claims 42 and 43 include the limitations in claims 4 and 5 surrendered in the application for patent.

Claims 48, 64, 81 and 86 include the same limitations in claims 10 and 11 surrendered in the application for patent.

Claims 53, 54, 68, 70, 91 and 92 include the limitations in claims 12 and 14 surrendered in the application for patent.

Claims 72-76 include the limitations in respective claims 12-20 surrendered in the application for patent.

Claim 77 includes the limitations in claims 21 and 22 surrendered in the application for patent.

Claim 78 includes the limitations in claim 23 surrendered in the application for patent.

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***Information Disclosure Statement (IDS)***

7. Applicant should submit the IDS which has all reference(s) cited in the parent application. The IDS must be received before this reissue application can be allowed.

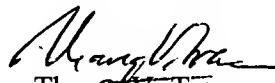
***Allowable Subject Matter***

8. Claims 1-37 are allowed over the prior art of record because the prior art of record, considered in combination or individually, fails to teach or suggest an optical disk including a combination of all limitations recited in each of claims 1 and 35, or an optical disk recorder including a combination of all features recited in each of claims 10, 24, 36 and 37. Claims 2-9, 11-23, 25-34 are allowed with their respective parent claim.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (703) 308-1551. The examiner can normally be reached on Tuesday to Friday, from 7:30AM to 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (703) 305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
Thang V. Tran  
Primary Examiner  
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